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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,873	08/05/2003	Alice H. Howe	MPH 03-13	9057
27990	7590	02/17/2005		
M. PAUL HENDRICKSON 403 MAIN STREET, P.O. BOX 508 HOLMEN, WI 54636-0508			EXAMINER CHIU, RALEIGH W	
			ART UNIT 3711	PAPER NUMBER
DATE MAILED: 02/17/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,873

Applicant(s)

HOWE, ALICE H. 

Examiner

Raleigh Chiu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4 and 6-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 6-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 4, 6, 7, 9, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over one of U.S. Patent Number 4,834,393 (Feldi) or French Patent Number 2,594,037 (Musslin) and either in view of U.S. Patent Number 5,077,870 (Melbye et al., hereinafter Melbye), U.S. Patent Number 6,401,997 (Smerdon, Jr., hereinafter Smerdon) and applicant's admission of prior art (AAPA).

Regarding claims 1, 4, 6, 7, 9, 10 and 12, Feldi discloses the combination of a tennis racquet equipped with a ball-retrieving attachment attached to the shoulder of a racquet wherein the ball-retrieving attachment can be a hooked fastener material such as Velcro™.

Musslin discloses another tennis racket having a hook fastener 3,4 configured to engage with the covering of the tennis ball. Musslin further discloses that "forms, dimensions and positions of the different elements, and the type of material used for the hooks could vary (change) within certain limits, without changing the general conception of the described

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invention" (last paragraph at page 3 of 4 from the English translation).

Melbye teaches that VelcroTM and ScotchmateTM were art-recognized equivalents in their use as hook-and-loop fasteners in the racquet art at the time of the invention. See column 1, lines 15 et seq. It would have been obvious to substitute a ScotchmateTM fastener in either the Feldi or Musslin racquet since Melbye teaches the equivalence of VelcroTM and ScotchmateTM fasteners and the selection of any of these known materials to form the fastener would be within the level of ordinary skill in the art.

Further, while it is noted here that none of Feldi, Musslin or Melbye discloses the recited hook size parameters such as monofilament diameter, hook height, hook width or hook depth, it is also noted that Smerdon teaches the use of hook-and-loop fasteners to removably attach a beverage tube to the side of a bicycle handlebar stem. Moreover, Smerdon discloses that those hook-and-loop fasteners should maintain good adhesion in wet and warm condition and examples of such fasteners are the ScotchmateTM SJ3526 fasteners. See the bridging paragraph between columns 11-12.

It further should be noted that tennis is generally considered to be an outdoor sport. In fact, among the sports'

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most famous tennis tournaments include Wimbledon and the U.S. Open, both of which are outdoor events that are played in wet and warm conditions. Wimbledon starts in the early summer in England and the tournament is well-known for its hot, wet and damp conditions; the U.S. Open occurs at the end of the summer tennis season in Flushing, New York and it is known for its hot and humid conditions.

Therefore, given the facts that (1) Feldi, Musslin and Melbye teach the concept of using hook-and-loop fasteners such as VelcroTM or ScotchmateTM with tennis racquets to retrieve grounded tennis balls; (2) tennis is often played in wet and warm conditions; and, (3) Smerdon explicitly discloses the preference of ScotchmateTM SJ3526 fasteners for their strong adhesive performance in wet and warm conditions, it would have been obvious to one of ordinary skill in the art to use ScotchmateTM SJ3526 fasteners in either the Feldi or Musslin racquets as modified above for the purpose recognized by Smerdon as discussed above.

Regarding the exact specifications of the ScotchmateTM SJ3526 fasteners, AAPA discloses that ScotchmateTM SJ3526 fasteners are in fact the preferred fasteners of choice and therefore such a substitution would naturally meet the disclosed

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dimensions of hook width, depth, diameter and density. See AAPA at page 5, lines 9-17 of the instant specification.

With further regard to claim 1, Feldi (Figure 1) and Musslin (Figure 3) show the racquet in tangential contact with a tennis ball.

With further regard to claim 10, although Feldi intends to provide an entirely new covering on a tennis ball, he also notes that it is old and well-known in the tennis art to pick up a standard tennis ball with a hook material affixed to the end of a tennis racquet. See column 1, lines 15-25. Further, as Musslin does not disclose the concept of covering the tennis balls with a different material, the Musslin racquet is considered to be used with standard tennis balls.

3. Claims 8, 11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feldi or Musslin in view of Melbye, Smerdon and AAPA as applied above and further in view of U.S. Patent Number 4,993,712 (Urwin).

Regarding claims 8, 11 and 13-15, it would have been obvious to one of ordinary skill in the art to place the ball-retrieving attachment between the three and nine o'clock positions of either the Feldi or Musslin racquet as modified above in view of Urwin who teaches at column 4, lines 8-13 that a ball-retrieving attachment comprised of hook-and-loop

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fasteners can be placed anywhere along the outer surface of the racquet frame.

Double Patenting

4. Claims 1, 4 and 6-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of co-pending Application No. 09/655,743. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same essential limitations of a specific hooked fastener material attached to the shoulder of a racquet are being claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

5. Applicant's arguments with respect to claims 1, 4 and 6-15 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (571) 272-4408. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich, can be reached on (571) 272-4415.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raleigh W. Chiu
Primary Examiner
Technology Center 3700

RWC:dei:feif

16 February 2005